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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,071	02/08/2002	John D. Pazienza	1133279-0017	4638

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PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

CHATTOPADHYAY, URMI

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/06/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,071

Applicant(s)

PAZIENZA ET AL.

Examiner

Urmi Chattopadhyay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,13,14,16,24-27,29 and 33-37 is/are allowed.
- 6) ☒ Claim(s) 2-11,15,17,18,21,22,30 and 31 is/are rejected.
- 7) ☒ Claim(s) 12,19,20,23,28 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

- key* a) On page 1, line 7, it appears that "continuation" should be changed to "divisional".
- ✓ b) On page 3, line 18, it appears that "us" should be changed to --up--.
- ✓ c) On page 6, line 20, "Figures 10, 3, 4a, 3b, and 3" is incorrect. Figure 3 is mentioned twice and there is no Figure 3b.

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- ✓ a) Claim 2: there is no support for the endzones expanding at a different rate from the first and second expandable elements.
- ✓ b) Claim 7: there is no support for the expanded diameter being greater than *12mm*. The specification discloses the diameter being greater than *12.0mm* on page 5, line 27.
- ✓ c) Claim 16: there is no support for square outer *ends*. The specification discloses the square outer *edges* on page 5, lines 19-20.
- ✓ d) Claim 17: there is no support for the expanded *radius* being 3-6 times the crimped *radius*. The specification discloses the expanded *diameter* as 3-6 times the crimped *diameter* on page 4, lines 4-5. *DON'T NEED*

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✓ e) Claim 21: there is no support for the tube having a diameter between 0.03 to 0.500 inches. The specification discloses the diameter as between 0.030 and 0.500 inches on page 5, line 29.

✓ f) Claim 25: there is no support for the ratio being greater than *approximately* 15%. The specification discloses the ratio as 15% on page 4, line 6.

Claim Objections

3. Claims 6, 10-12, 15, 23, 28 and 32 are objected to because of the following informalities:

- ✓ a) Claim 6, line 2, "an" should be changed to --at--.
- ✓ b) Claim 10, line 2, "pluarlity" should be changed to --plurality--.
- ✓ c) Claim 11, line 2, a period is needed after "Z-shaped".
- ✓ d) Claim 12, line 3, "expanable" should be changed to --expandable--.
- ✓ e) Claim 12, lines 8 and 9, "for" should be deleted to positively claim the struts as joining elements together, rather than in terms of intended purpose.
- ✓ f) Claim 12, line 10, "sements" should be changed to --segments--.
- ✓ g) Claim 12, line 12, the period should be changed to a semicolon.
- ✓ h) Claim 12, line 14, "within a portion of another" should be changed to --within another portion of--.
- ✓ i) Claim 15, line 2, --that-- should be inserted after "length".
- ✓ j) Claim 23, line 1, "it to" should be changed to --onto--.
- ✓ k) Claim 28, line 1, "the first" should be changed to --each first-- (see claim 26).

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- ✓ 1) Claim 32, line 7, "first helical" should be changed to --helical first--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-11, 15, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- ✓ 5. Claim 2 recites the limitation "elements" in line 3. There is insufficient antecedent basis for this limitation in the claim. It appears that "elements" should be --segments--.
- ✓ 6. Claim 9 recites the limitation "elements" in line 1. There is insufficient antecedent basis for this limitation in the claim. It appears that "elements" should be --structures--.
- ✓ 7. Claim 15 recites the limitation "filament" in line 1. There is insufficient antecedent basis for this limitation in the claim.
- ✓ 8. Claim 30 is indefinite because "struts" on line 1, "first elements" on lines 3-4 and "second elements" on lines 5-6 are referring to the same mention in claim 26. It appears that --the-- should be inserted before "struts", "first" and "second" to make it clear that claim 30 is further limiting those elements of claim 26 and not introducing new elements.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 17, 18, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Colgan et al. (USPN 6,264,689).

Colgan et al. discloses a stent with all the elements of claim 17. See Figure 2A for a stent having a generally cylindrical main body comprising a plurality of helical segments, wherein at least one helical segment crosses another helical segment. See column 4, lines 5-8 for the stent having a crimped radius (stent is within a 7 or 8 French catheter, which means the catheter has an outer diameter of 2.3 or 2.7mm, so the stent within it has to have an even smaller diameter) and an expanded diameter (10mm) that is 3-6 times the crimped diameter.

Claim 18, see Figures 8A-8D for helical segments contracting and expanding when stent is crimped and expanded.

Claims 21 and 22 are product-by-process claims, and according to MPEP § 2113, these claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. The patentability of a product does not depend on its method of production, but on the product itself. The wires of Colgan et al. are certainly capable of being produced from laser cutting a tube of the required diameter.

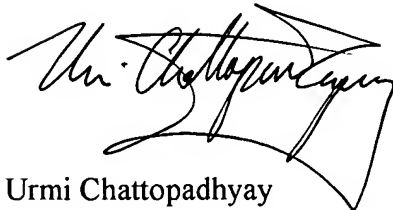
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Allowable Subject Matter

11. Claims 1, 12-14, 16, 23-29 and 32-37 are allowed.
12. Claims 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 872-9306. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmi Chattopadhyay

Art Unit 3738

September 30, 2003



David J. Isabella
Primary Examiner